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EXAMINER	
JANVIER, JEAN D	

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3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/978,170	ROSENBERG ET AL.	
	Examiner	Art Unit	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-11,13-18,20 and 22-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 5-11, 13-18, 20, 22-28 and 29-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Re-Open Prosecution

In view of the Applicant's comments recorded in the 01/25/10 interview summary and in the 37 CFR request for reconsideration, filed on 02/08/2010, PROSECUTION IS HEREBY REOPENED and a Non-Final Action follows.

Response to Applicant's Arguments

Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of new grounds of rejection.

DETAILED ACTION

Specification

Priority Document

The current reference, US2003/0037068A1, claims domestic priority, under 35 USC 119(e), to Provisional Application 60/193,894, filed on March 31, 2000. In other words, the current reference, US2003/0037068A1, used in the Action, is said to be available as prior art based on its effective filing data. Thus, the Action is heavily based on the Provisional Application disclosure.

Status of the claims

Claims 1-2, 5-11, 13-18, 20, 22-28 and claims 29-30 are currently pending in the Instant Application.

Examiner's Notes

Regarding claim 16, although it is understood that the system continues to display the user's selected program content when entering the pause mode, however, it is unclear what the Applicant meant to refer to by "displaying **a pause banner** during the pause mode" unless **"pause banner"** is equivalent to paused content (image/picture) or user's selected program content.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1,** 5-11, 13-18, **20, 22,** 24, 26, 27, **29** and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas, US2003/0037068.

As per claims **1,** 5-11, 13-18, **20, 22,** 24, 26, 27, **29** and 30, Thomas discloses an invention that that relates to media recording systems and, more particularly, to media recording systems that provide for pausing of real-time or played-back media ([0002], [0008], [0045]).

In general, viewers and listeners of media, such as video and audio media, television programs, pay-per-view programs, such as NVOD (Near Video-On-Demand), VOD (Video-On Demand), typically record such media on video-cassettes, audio cassettes and other storage media. More recently, products have been developed that allow users to manage their viewing experiences and record media with increased flexibility. Personal video recorders (PVRs), such as those provided by TIVO and REPLAY, record programs or media on hard-disk drives **(locally recording media, TV programs and so on to be later retrieved for real-time playback via the PVRs or video replay system).** Users can schedule, using such recorders, programs for recording and play them back at a later time. Those systems also record what users are watching in real-time, thereby allowing the users **to pause, by pressing a pause key on a remote control,** real-time programs when, for example, the user must leave the room. Users may resume their viewing upon returning, where they left off and may even fast forward through commercials, using the remote control, until they reach the point at which the program is currently provided. Users may also rewind programs **([0003], [0004])**.

In conventional systems, pausing a real-time or recorded program causes the system to "freeze" the current picture. For anyone viewing the media, the time the program is paused is useless or frustrating ([0005]).

The present media recording system (video replay system) provides users with opportunities to record media, such as television programs (data stream), VOD programs, NVOD

programs, audio programs or any other suitable program, as is conventionally done with, for example, conventional videocassette recorders and PVRs (personal video recorders). Users may record media in real-time with VCR like functionality. The system may record media in real-time in response to, for example, the user indicating a desire to pause or rewind a program **by pressing a key or button on a remote control**. Users may also record media while reviewing other media (e.g., recording one program while watching another) or schedule media for unattended recording ([0029]).

Thomas specifically discloses that when a user pauses, **using a pause key on a remote control or on the user's PVR (video replay system or VRS)**, real-time or recorded program **(video stream)**, **stored on a storage medium coupled to the user's PVR (e.g. TIVO box) or video replay system (VRS)**, **currently being played on the screen/display of the video replay system**, the media recording system or PVR (video replay system or VRS) **enters a pause mode that pauses or freezes the played/displayed or user's selected program for a few seconds ([0005]), which literally means that the paused or user's selected program continues to be displayed thereon, before the image/picture (user's selected program) disappears or simply fades away and, subsequently or after a time delay has expired or elapsed, the PVR or VRS** presents pause-time content, including advertisement, instead of a paused picture (recorded TV program or video data stream) of the last frame. Pause-time content may be any combination of video, audio, graphics, text, animations or other media or advertisements. If video and/or audio is used, pause-time content may be sent, for example, in real time over a broadcast channel. This may allow multiple users to have access to the same pause-time content. In another suitable approach, audio or video may be shared on a server and sent on demand. **This may provide a**

customized pause-time experience for each user. **The pause-time content may be, for example, advertisements, summaries of what has been reviewed already, or any other suitable media**. The pause-time content may be based on the position in the recorded or real-time media at which the recorded or real-time media was paused. Summaries may, for example, summarize any portions of media that have been reviewed by the user. **Advertisements may be based, for example, on the content of the paused position of the recorded or real-time media**. When the user pauses VOD programs, for example, the VOD program may be paused and pause-time content substituted. **Pause-time content may be sent from the VOD server instead of the now- paused program. Alternatively, the pause-time content may be generated in the user's equipment or using any other suitable approach or combination of approaches ([0042]; figs. 5 and 6)**.

Moreover, when the user pauses NVOD programming, for example, the system may stop showing the currently selected showing and replace it with pause-time content **such as an obtained ad**. When the viewer ends the pause, the system may stop the pause-time content and resume the currently selected showing with the showing nearest to where the user left off (e.g., another ~ showing that started fifteen (15) minutes later than the selected showing-**[0042]; figs. 4-6**).

Further, the system provider may provide pause-time content to the system for presentation at pause-time. The content may be provided using any suitable approach. The content may be provided simultaneously with a program, such as in the vertical blanking interval (VBI), or in a digital track on a digital channel. Alternatively, the pause-time content may be provided separate from the media. Suitable software, such as a guidance application for the

recording device, may receive the content and present it to the user upon pausing of real-time or recorded media ([0040] and [0047]).

In addition, Thomas discloses that an enhanced data set herein referred to as "metadata" may be used to describe programming. Metadata may include any information that may be associated with media that describes the media, its content, or services related to the program. Metadata may describe, for example, the content of a program, whether commercials may be skipped on playback, the clothes that an actor is wearing, or anything else about the program. Pause-time content may be included in the metadata for the media. In another suitable approach, pause-time content may be provided separately and stored by the system. The metadata may include references to or identifiers for the pause-time content ([0011], [0023], [0025], [0044] and fig. 7).

In one aspect of the present system, Thomas teaches that pause-time advertisements may be targeted based on metadata. For example, each scene may show a different product. In the paused scene of a program, an actor is driving a certain car and wearing particular clothes. The metadata for that program or scene may indicate the car, clothes, etc. In one approach, indicators of the advertisements may be included in the metadata. In another approach, the program guide or other software may select an advertisement from advertisements available on the system based on, for example, the description of the scenes in the metadata. In this way, the advertisement for a product is enhanced because the viewer can watch the product or service as it is worn, used, provided ([0011], [0023], [0025], [0044] and fig. 7).

The program guide may provide users with opportunities to pause real-time or recorded programs. In response to a user pausing a program, the program guide may present pause-time

content (e.g. advertisements). Pause-time content may be provided to the program guide using any suitable approach. Pause-time media content may, for example, be provided as part of the program guide data and stored by the program guide until used. At some suitable frequency (e.g., periodically, on-demand, via polling, etc.), the system provider may replace the stored pause-time content with new content having the same identifier. When recorded programs are paused, the new pause-time content is retrieved and presented on the display or screen of coupled to the PVR or video replay system ([0011], [0023], [0025], [0044] and fig. 7).

In another suitable approach, the guide client (or web browser if an on-line guide is used) may request pause-time content when a program is recorded, paused, or at any other suitable time, from a server. If desired, program guide metadata may include a source reference for pause-time content. The source reference may be, for example, a universal resource locator (URL). When a program is recorded, the source reference may be recorded or otherwise stored by the guidance application. On playback, the guide may request pause-time content from the server based on the URL. The content that is presented will be the content currently available with the URL. As time passes, the provider of the pause-time content may change the contents of the file associated with the URL to, for example, make the pause- time content more appropriate for the current time. In this way, "fresh" pause-time content may be presented each time a user pauses a real-time or recorded program ([0011], [0023], [0025], [0044] and fig. 7).

Finally, with respect to at least independent claims 1, 20 and 29, Thomas discloses that when a user pauses, **using a pause key on a remote control or on the user's PVR (video replay system or VRS)**, real-time or recorded program **(video stream)**, **stored on a storage medium coupled to the user's PVR (e.g. TIVO box) or video replay system (VRS)**,

currently being played on the screen/display of the video replay system, the media recording system or PVR (video replay system or VRS) **enters a pause mode that pauses or freezes the played/displayed or user's selected program for a few seconds ([0005]), which literally means that the paused or user's selected program continues to be displayed thereon, before the image/picture (user's selected program) disappears or simply fades away and, subsequently or after a time delay has expired or elapsed, the PVR or VRS** presents pause-time content, including advertisement, instead of a paused picture (recorded TV program or video data stream) of the last frame. Pause-time content may be any combination of video, audio, graphics, text, animations or other media or advertisements. If video and/or audio is used, pause-time content may be sent, for example, in real time over a broadcast channel. This may allow multiple users to have access to the same pause-time content. In another suitable approach, audio or video may be shared on a server and sent on demand. **This may provide a customized pause-time experience for each user**. **The pause-time content may be, for example, advertisements, summaries of what has been reviewed already, or any other suitable media**. The pause-time content may be based on the position in the recorded or real-time media at which the recorded or real-time media was paused. Summaries may, for example, summarize any portions of media that have been reviewed by the user. **Advertisements may be based, for example, on the content of the paused position of the recorded or real-time media**. When the user pauses VOD programs, for example, the VOD program may be paused and pause-time content substituted. **Pause-time content may be sent from the VOD server instead of the now- paused program. Alternatively, the pause-time content may be generated in the user's**

equipment or using any other suitable approach or combination of approaches ([0042]; figs. 5 and 6). See also [0011], [0023], [0025] and [0044].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, US2003/0037068 in view of Official Notice.

As per claim 2, although Thomas implicitly discloses displaying an ad after a time delay, related to pausing a real-time or recorded program or video, has elapsed or expired, however, Thomas does not expressly disclose that the user is allowed to set the time delay.

However, Office Notice is taken that it is common practice in the art that a user sets a time delay after which a system enters a pause mode and presents thereon a pause-timing content. For example, a user of a computer system can set a time delay related to a screensaver program such that when the time delay has expired or elapsed, following an idle period or period of inactivity, a scheduled or preset program or pause-timing content is presented on a screen coupled to the computer system.

Therefore, it would have been obvious to an ordinary skilled artisan, implementing the Thomas's system, at the time of the invention to incorporate the above disclosure ("Official Notice") into the Thomas's system so as to enable a user to set a time delay after which an ad can be played or displayed after pausing a real-time or recorded program or video, thereby providing control to the user as to when a pause-timing content or ad can be displayed after pausing a real-time or recorded program or video, while rendering the system more interactive and appealing to the user.

As per claim 23, although Thomas implicitly discloses that the pause key or button is located on a remote control and/or on the user's PVR (personal video recorder system), VCR and so on (video replay system), as conventionally used in the industry, however, it appears that Thomas does not implicitly or explicitly disclose that the pause key or button is on a display coupled to the video replay system (PVR, VCR, etc.).

However, Official Notice is taken that it is well known in the art for a user or TV viewer to pause a real-time program or recorded media, such as a video, currently being viewed on a TV monitor by pressing the pause key/button on the remote control or on a VCR (video replay system). For instance, a viewer watching a real-time or pre-recorded video, stored on a local storage medium, on a TV monitor can pause the display of the video at will by pressing the pause key on the related remote control or on the face of a VCR unit (video replay system).

Further, as per claim 23, placing the pause key/button on a display/screen coupled to the video replay system, PVR or VCR instead of a remote control or on the face of a PVR or VCR is a matter of desires, which does not directly impact the utility or functionality of the system.

Therefore, it would have been obvious to an ordinary skilled artisan, implementing the Thomas's system, at the time of the invention to incorporate the above disclosure ("Official Notice") into the Thomas's system so as to place a pause key/button on a display/screen coupled to the video replay system, PVR or VCR, in addition to a remote control or on the face of a PVR or VCR, useful in triggering a pause mode that pauses real-time or recorded program or video (user's selected program) on a display of the video replay system, PVR or VCR for a few seconds before displaying an ad, thereby enabling the user to pause a real-time or recorded program or video using a plurality of options before the system (video replay system) replaces the paused content with an ad.

As per claims 25 and 28, Thomas does not expressly teach that the video replay system is a handheld device or cellular device (handheld video player).

However, Official Notice is taken that it is common practice in the art to use handheld, mobile, portable or wireless (cellular) devices to play or display real-time or recorded program or video (**See USP 6,332,127 to Bandera**).

Therefore, it would have been obvious to an ordinary skilled artisan, implementing the Thomas's system, at the time of the invention to incorporate the above disclosure ("Official Notice") into the Thomas's system so as to use a handheld, mobile, wireless or portable device

(video replay system), including a laptop or notebook computer, to display an ad after the user of the portable device pauses a real-time or recorded program or video (user's selected program content) by pressing on a pause key or button on the handheld or cellular device, thereby allowing a mobile user or subscriber (road warrior) to participate in the pause content display system that is configured to display news, sports and advertisements when a pause mode is being triggered by the user, while expanding the use of the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,884, 141 to inoue discloses a video signal receiver receives a plurality of video channels simultaneously carrying, offset by a transmission interval, a single video program, selects one channel from which to obtain the program for display to a user, and achieves a pause function in the display of the transmitted video program by temporarily storing a segment of the video program equal to the length of the transmission interval and obtaining the remainder of the program at a later time from the same or another channel (See abstract).

USP 6,349,410 to Lortz discloses the coordination of the display of an incoming signal stream (such as broadcast TV content or streaming web content) on a display with web browsing. The method includes storing a uniform resource locator (URL) associated with the incoming signal stream being displayed, receiving a first signal to display web content associated with the URL, pausing display of the incoming signal stream while storing the incoming signal

stream on a storage device, and obtaining and displaying the web content associated with the URL. The method further includes receiving a second signal to resume display of the incoming signal stream, removing the web content from the display, and resuming display of the incoming signal stream at the point that the pause occurred by obtaining the incoming signal stream from the storage device (See abstract).

US Patent 5, 959, 621 to Nawaz discloses a system for displaying data items in a ticker display pane (dynamic component) on a client computer or computer workstation or target system 184 wherein a user's client computer 184 receives from at least one or more sources or service providers over the Internet (global communication network) data including data items and/or advertisements (stream data) to be displayed on a ticker pane 142 of fig. 3 on a screen desktop 104 of fig. 3 associated with the client computer 184 and wherein the data or data items are displayed in a sequence where the data items or stream of data 150, 152, 154 and 156 are being replaced or updated on the ticker display pane 142 so as to display data item 156 on the first end 170 until the last data item 150 on the second 172 and the sequence restarts until the last data item is displayed on the ticker pane. Here, the data items are displayed on the ticker pane in a substantially continuous manner. Furthermore, the data items are being replaced or updated on a scheduled basis in an effort to have up-to-date information, downloaded directed from the content providers, displayed on the ticker pane 142 on a substantially continuous basis. In addition, stream of data 150, 152, 154 and 156 (identifier or content teaser) displayed within the ticker display pane 142 can contain hyperlinks to link the user or the customer to the original sources or providers of the information or data or full content related to the data items or identifiers 150, 152, 154 where he can receive more detailed information or full content directly

from a source or content provider upon clicking on a hyperlink within a content teaser or identifier or data item 150 to thereby visit the source or content provider's web site. For instance, source identifier 144 of fig. 3, identifying the source or the provider (ESPN) of the stream of data or data items 150, 152, 154 and 156, displays an image associated with the source of the data items currently displayed on the ticker display pane 142 and may also include a hyperlink, which upon activation by the user or customer causes the system to retrieve and display a document on a server computer **or host (web page)** corresponding to the hyperlink wherein the displayed information or full document may represent advertising information. The source identifier 144 may further be an HTML page, **displayed on a web page**, allowing the content provider to place advertisements and other information in a display space for the source identifier (See abstract; figs 3-4 and 7; col. 3: 20 to col. 4: 9; col. 8: 14 to col. 9: 8). Finally, the user or the customer can customize the ticker display pane 142 (dynamic component) using the option button 160 of fig. 3 that allows the user or customer to, for example, customize provided content or to select information sources; otherwise the system or the host or server system will control how the data items or content teaser should be displayed in the ticker display pane 142 and select which information sources will provide the data items (host customizes dynamic component) (col. 9: 37-48; claim 6 of the current reference). It is herein understood that the user's computer is coupled to a web site (first web site), over a computer network or the Internet, where data items or content teasers or identifiers can be downloaded or retrieved in real-time from sources or content providers (content web sites) and displayed on the user's computer and wherein, upon clicking on a hyperlink embedded within a content teaser or identifier or data item, the user or customer can visit the source or content provider's web site (first content web site) to request or

receive full content or full document, such as full sport news, associated with a content teaser or sport news headline from ESP network that was selected or activated by the user or customer.

USP 5,774,170 to Hite discloses a system wherein when a match is found between a locally stored CID and the CID (commercial ID) transmitted with the advertisement or commercial, the commercial or advertisement is then presented to the viewer. If there is no match, then the inserted commercial is ignored or discarded **(determining if a CID code or data element transmitted within an advertisement embedded in a data stream/broadcast is compatible to a local condition or locally stored CID code, representing the viewer's interest or preference, before temporarily storing the advertisement in the memory (cache memory) and displaying it during a triggering event or programming or data stream break).**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Ms. Lynda Jasmin, can be reached at (571)272-6782.

Non-Official-571-273-6719.

Official Draft: 571-273-8300

103/22/10

/J. J./

/Jean Janvier/
Primary Examiner, Art Unit 3688